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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/514,699	02/28/2000	Weizhong Zhao	D/98621	8912

7590

02/10/2004

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EXAMINER

NOTE, JANIS L

ART UNIT

PAPER NUMBER

1756

DATE MAILED: 02/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Art Unit: 1756

1. The amendment filed after a decision rendered by the Board of Patent Appeals and Interferences (BPAI) on Oct. 21, 2003 (BDA102103), is not responsive to the rejection under 37 C.F.R. 1.196(b) set forth in the decision by the BPAI mailed on Sep. 30, 2003 (APDA093003). Nor is the amendment BDA102103 responsive to the outstanding objection to the specification as set forth in the Final rejection mailed on Dec. 21, 2001.

The amendment is not responsive for the following reasons:

(a) Claim 10, presented as amended claim 1, did not amend the claim language of claim 10 to overcome the rejection under 35 USC 112, second paragraph, set forth by the BPAI. Applicants merely amended claim 1 by incorporating the claim language recited in claim 10 that was previously determined to be indefinite by the BPAI. Compare amended claim 1 in BDA102103 and previously presented claim 10 filed on Jan. 15, 2002. In addition, applicants added new claims 21-30 that were not directed to the subject matter recited in the appealed claims 1-10, but directed to a non-elected invention.

(b) Applicants did not provide any arguments as to why the claim language recited in claim 10 is patentable over the rejection under 35 USC 112, second paragraph, set forth by the BPAI.

(c) Applicants did not amend the specification to capitalize the trademarks disclosed in the specification to overcome the objection to the specification set forth in the Final rejection, paragraph 5.

See 37 CFR 1.111, and MPEP 1214.01(I).

2. For the reasons discussed in paragraph 1, items (a) and (b), the amendment BDA102103 has not been entered. See MPEP 1214.01(I).

3. In reply to this non-responsive notice, applicants may proceed by either options (A) or (B) described infra.

(A) In order to be fully responsive to the rejection under 37 CFR 1.196(b) and the Final rejection, and to place the application in condition for allowance, the examiner suggests that the following amendments to the claims and the specification:

(1) Amend claim 1, after the phrase "redispersing the reclaimed undeveloped developer cake in the second developer liquid," by inserting the phrase -- and wherein the reclaimed undeveloped cake is kept separated from the second liquid developer until the solids content of the second liquid developer drops below from about 6 to about 10 weight

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percent --. The recitation of the phrase "kept separated" was suggested by the BPAI to avoid the 112, second paragraph, rejection. See the decision, page 11, last full paragraph.

(2) Cancel claims 11-20, which are drawn to the non-elected invention. See the Final rejection mailed on Dec. 21, 2001, paragraph 2. Prosecution is closed, but for response to the BPAI's new ground of the rejection. See MPEP 1214.01(I).

(3) Capitalize all the trademarks cited in the instant specification, e.g., page 27, and the trademarks "Elvax 200W [sic: ELVAW 200W]" and "Isopar M {sic: ISOPAR M} cited in the amended paragraphs beginning at page 26, line 14, and page 27, line 1, respectively, of the specification, filed in the amendment on Jul. 25, 2001.

(4) Amend the specification at an appropriate location to include the essential material incorporated by reference from now-abandoned US application 09/963,360, which is incorporated by reference in its entirety in the instant specification. See the instant specification at page 1, line 10, and page 22, line 29, to page 23, line 2. The amendment must be accompanied by an affidavit or declaration stating that the amendatory material consists of the same material incorporated by reference in the application. MPEP 601.01(p) Section A.

(This requirement for allowance was previously presented in the Final rejection mailed on Dec. 21, 2001, paragraph 3.)

Applicants must address all four items to place the application in condition for allowance. If applicants do not amend the claims and specification as proposed above, applicants' response may be held non-responsive and the application held abandoned.

(B) File a continuation within the time period set infra.

4. Since the above-mentioned amendment appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omissions or corrections in order to avoid abandonment. NO EXTENSIONS OF THIS TIME PERIOD WILL BE GRANTED UNDER 37 CFR 1.136(a).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The central fax phone number is (703) 872-9306.

Any inquiry of papers not received regarding this communication or earlier communications should be directed to

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Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

JLD

February 2, 2004

Janis L. Dote
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GROUP 1580
1700